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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------------|------------------|
| 10/606,962 | 06/27/2003 | Seiji Horie | 019519-395 | 4849 |
| 7590 01/06/2006 BURNS, DOANE, SWECKER & MATHIS, L.L.P. P.O. Box 1404 Alexandria, VA 22313-1404 | | | EXAMINER SHOSHO, CALLIE E | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1714 | |

DATE MAILED: 01/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/606,962

Applicant(s)

HORIE ET AL.

Examiner

Callie E. Shosho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,10,11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 9/26/05.

It is noted that applicants' filing on 9/26/05 of English translation of foreign priority document previously filed on 3/7/05 perfects the foreign priority filing date.

The new grounds of rejection set forth below are necessitated by applicants' amendment and thus, the following action is final.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 3, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Takao et al. (U.S. 2002/0077383).

The rejection is adequately set forth in paragraph 5 of the office action mailed 5/26/05 and is incorporated here by reference.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 3, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (U.S. 6,197,847) in view of EP 1205815.

The rejection is adequately set forth in paragraph 8 of the office action mailed 5/26/05 and is incorporated here by reference.

Response to Arguments

6. Applicants' arguments regarding Horie (U.S. 2003/0225168) and Tsubuko et al. (U.S. 4,360,580) have been fully considered but they are moot in view of the discontinuation of the use of these references against the present claims.

7. Applicants' arguments filed 9/26/05 have been fully considered but, with the exception of arguments relating to Horie et al. and Tsubuko et al., they are not persuasive.

Specifically, applicants argue that Takao et al. is not a relevant reference against the present claims given that Takao et al. do not disclose pigment subjected to surface treatment as required in the present claims. Applicants state that the office action at page 4 acknowledges Takao et al.'s failure to disclose the claimed surface treatment.

However, page 4 of the office action mailed 5/26/05 sets forth the examiner's position that the colored particles of Takao et al. are produced by difference process than presently claimed but that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even

though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) . Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product” *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983).

It is the examiner’s position that Takao et al. do disclose pigment subjected to surface treatment as presently claimed. Specifically, paragraph 23 of Takao et al. discloses the use of pigment subjected to surface treatment, i.e. pigment that has silicone graft polymer absorbed thereto by one or more of a combination of chemical bonding, physical adsorption, mechanical adsorption, and physiochemical adsorption. It is noted, for instance, that the chemical bonding includes surface treated pigment formed by reaction between basic site on surface of pigment and acidic cite on the polymer which is identical to surface treatment utilized in the present invention.

In light of the above, the examiner’s position remains that Takao et al. do disclose pigment subjected to surface treatment as presently claimed.

Applicants also argue with respect to the rejection utilizing Kato et al. in combination with EP 1205815 that EP 1205815 is not a relevant reference against the present claims given that while EP 1205815 discloses the use of pigment subjected to surface treatment, there is no disclosure that the beneficial effects achieved using such pigment would be achieved if the surface treated pigment was coated with additional coating by polymerization dispersion.

Applicants argue that EP 1205815 provides no motivation for or suggestion of using the treated pigment as an “inner” surface of a colored particle.

It is agreed that there is no disclosure in EP 1205815 that the pigment subjected to surface treatment is coated by additional coating by dispersion polymerization as presently claimed. However, EP 1205815 is not used for its teaching of such colored particles. Kato et al. already disclose oil-based ink comprising resin particles containing coloring material wherein the resin particles have mean particle size of 0.08 μm to 0.8 μm . However, there is no disclosure in Kato et al. that the coloring material is a pigment that is subjected to surface treatment. This is why Kato et al. is used in combination with EP 1205815.

While there is no disclosure in EP 1205815 of colored particles as presently claimed, note that EP 1205815 is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely the use of pigment subjected to surface treatment in ink jet inks improves the dispersion stability and charge characteristics of the ink, and in combination with the primary reference, discloses the presently claimed invention.

Further, it is noted that while EP 1205815 does not disclose colored particles as presently claimed, EP 1205815 does disclose that the pigment subjected to surface treatment is dispersed in an organosol, i.e. core-shell polymer. Thus, given that the pigment subjected to surface treatment of EP 1205815 achieves beneficial effects when dispersed in organosol or core-shell polymer, it would have been obvious to one of ordinary skill in the art that the pigment would

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also achieve such benefits when coated with addition coating by dispersion polymerization as set forth in Kato et al.

In light of the above, it is the examiner's position that the combination of Kato et al. with EP 1205815 is proper.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS

1/3/06